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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/652,115	08/30/2003	James J. O'Connor	0020-3 CIP	1836
25901	7590	01/10/2005	EXAMINER	
ERNEST D BUFF & ASSOCIATES, LLC			JAGAN, MIRELLYS	
245 SOUTH ST			ART UNIT	
MORRISTOWN, NJ 07960			PAPER NUMBER	
			2859	

DATE MAILED: 01/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>		<b>Applicant(s)</b>	
	10/652,115		O'CONNOR, JAMES J.	
	<b>Examiner</b>		<b>Art Unit</b>	
	Mirellys Jagan		2859	

– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 25 October 2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,2 and 5 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 5 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 August 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Election/Restrictions*

1. The amendment filed on 10/25/04 cancelled claims 3, 4, and 6-8, which were drawn to non-elected inventions. The election/restriction requirements stated in the last Office action, dated 8/19/04, is hereby repeated and thus made final.

### *Claim Rejections - 35 USC § 103*

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 2, and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,598,638 to Plesh in view of U.S. Patent 5,222,303 to Jardine and U.S. Patent 2,713,203 to Gottlieb.

Plesh discloses an apparatus for marking the location of electrical boxes on a wall, the apparatus having:

an elongated body with first and second ends and front and back sides; and

notches disposed on the body at a plurality of locations each determining placement of a box for marking the position of the box above a floor (regular or irregular) in accordance with desired standards such that a single box may be located at different heights (11, 13, 17) that are unrelated to each other;

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wherein the width of the first end of the body is 2-4 inches (see figure 1; and column 4, lines 55-60).

Plesh does not disclose the apparatus having a set of indicia along both edges of the front side for indicating the distance from the first end; a level for leveling the length of the apparatus vertically; a textual portion of the standard or code; and the notches having slots for marking the position of the electrical boxes.

Jardine discloses an apparatus for marking the location of electrical boxes on a wall, the apparatus having an elongated body with first and second ends and front and back sides. A set of indicia are along an edge of the front side for indicating the distance from the first end, and a pair of levels are provided for leveling the length of the apparatus horizontally and vertically. An aperture (16) is used to mark the position of electrical boxes above a floor (regular or irregular) in accordance with selected standards and codes (see column 3, lines 1-6).

Gottlieb discloses a measuring apparatus for marking and locating the position of a cut line, the apparatus having an elongated body with a plurality of slots disposed on the body at a plurality of locations each determining the placement of the cut line conforming to building laws and other requirements [i.e., codes and standards] for marking a straight line, and a set of indicia located along each edge of the front side for indicating the distance of the slots from the first end. Gottlieb teaches that indicia (notches) may be also placed directly along the side edges of the body in order to facilitate making a horizontal mark along both sides of the body. Gottlieb teaches that the distance of the slots from the first end can be indicated on the front side by any desired indicia, and that the apparatus may have text for indicating instructions

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and guidelines to allow an inexperienced individual using the apparatus to conform to building laws and other requirements [i.e., codes and standards](see column 3, line 68-column 4, line 10).

Referring to claim 1, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the apparatus disclosed by Plesh by adding a level and indicia, as taught by Jardine, in order to level the apparatus horizontally and properly orient and position the boxes, and in order to determine the distance of the notches from the floor when marking the box locations, i.e., to determine which notch is the appropriate distance from the floor.

Furthermore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the notches disclosed by Plesh by adding apertures as taught by Gottlieb, in order to allow a user to mark a horizontal straight line when marking the location of the boxes.

Furthermore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the apparatus disclosed by Plesh, Jardine, and Gottlieb by providing another set of indicia on the other edge of the body, in order to facilitate marking along both sides of the body, and since it has been held that the mere duplication of the essential working parts of a device involves only routine skill in the art. See St. Regis Paper Co. v. Bemis Co., 193 USPQ 8.

Referring to claim 2, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the apparatus disclosed by Plesh, Jardine, and Gottlieb by adding a textual portion of the standard or codes on the apparatus since Gottlieb teaches that providing a text of building laws or other requirements is beneficial since it allows

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an inexperienced individual using the apparatus to conform to building laws and other requirements.

*Response to Arguments*

4. Applicant's arguments with respect to claims 1, 2, and 5 have been considered but are moot in view of the new ground(s) of rejection.

*Conclusion*

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The following patents disclose a measuring apparatus for placing an electrical box:

U.S. Patent 5,966,828 to Hickey

U.S. Patent 5,111,593 to Gehen, Sr.

U.S. Patent 2,990,172 to Gianotta

U.S. Patent 4,793,069 to McDowell

U.S. Patent 5,615,490 to Burchell

U.S. Patent 5,072,523 to Bennett

U.S. Patent 6,233,838 to Falwell et al

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mirellys Jagan whose telephone number is 571-272-2247. The examiner can normally be reached on Monday-Friday from 10AM to 4PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Diego Gutierrez can be reached on 571-272-2245. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MJ



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